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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/764,350

**Applicant(s)**

SUDA, TAKASHI

**Examiner**

KAMAL B. DIVECHA

**Art Unit**

2151

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 1-4, 6 and 8-21 are pending in this application.

Claims 5 and 7 were previously cancelled.

Claim 22 is cancelled in response filed 3/24/08.

**Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 3/24/08 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **3/24/08** has been entered.

**Response to Arguments**

Applicant's arguments in the submission filed on 3/24/08 have been fully considered but they are **not** persuasive.

In response filed, applicant argues in substance that:

- a. Claim 1, as amended, falls within one of the four statutory categories (e.g. machine) (remarks, pg. 7).

In response to argument [a], Examiner respectfully disagrees.

Independent claim 1 recites:

“A **computer-implemented apparatus** for managing addresses of websites comprising:  
an address list...  
a monitor monitoring... and  
an updating processor updating...”

The claim as amended still fails to fall into any of the four enumerated categories of 35 USC 101 simply because the claims lacks the necessary physical articles or objects such as a computer memory and/or computer processor to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter.

As such, they continue to fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

The “monitor monitoring...”, “updating processor updating...” and “address list” can be implemented as a computer program or software code (see applicant specification, pg. 28: browser assistant software).

Moreover, the specification is clearly evidenced to disclose the process of monitoring and the process of updating in form of computer programs, e.g. applicant specification, pg. 7-9, 12.

An address list can merely be a data structure associated with a computer program.

As acknowledged by the applicant in the previous responses, MPEP 2106 (IV)(B)(2)(b)(ii) indicates that if a claim identifies the **physical structure of a machine** in terms **of its hardware or hardware and software combination**, the claim defines a statutory product.

In the instant case, the claim fails to identify even a single physical structure of a machine such as a computer processor e.g. CPU 2 of fig. 1, a computer memory e.g. hard disk, ROM or RAM of fig. 1, etc., in order to realize the functionalities of programs.

Furthermore, since the specification fails to recite the term “updating processor”, the term is interpreted as “updating section”, which is disclosed throughout the specification, and the fact

that the term “updating section” can be implemented as a computer program and/or program, **the term “updating processor” is interpreted as a computer program.**

In other words, there is no indication whatsoever in the specification as filed that the term “updating processor” corresponds to a physical processor of a computer system only such as CPU 2.

b. Li is related to a system for personalizing, organizing and managing web information. **The office action explicitly acknowledged that Li** does not disclose if no input is supplied over a predetermined time period with respect to reference to any of the web sites...(remarks, pg. 7-8).

In response to argument [b], Examiner respectfully disagrees.

Initially, it should be noted that the office action acknowledged that Li does not disclose a means wherein, if the number of times the access failure has occurred with respect to one of the addresses contained in said address list becomes equal to a predetermined threshold value, said updating section deletes the one of the addresses from said address list, said updating section tries to access each of the addresses contained in said address list and deletes an address from said address list if the number of times failure has occurred continuously becomes equal to a predetermined threshold value by failure of said tries (**i.e. a typical “retry mechanism”** before deleting the addresses from the list, or testing the number of times access failure has occurred before deleting the addresses from the list as per applicant); and

**Li discloses if no input is supplied over a predetermined time period** with respect to reference to any of the web sites, said updating section tries to access each of the addresses

contained in said address list and deletes an address from said address List (col. 7 L15 to col. 8 L60, col. 10 L14 to col. 11 L45, and fig. 19: clearly summarizes Li's invention).

c. However, claim 1 has been amended to recite...so as to delete an address of a relocated or extinguished web site from said address list...Chung does not teach or suggest the above-mentioned features recited in claim 1 (remarks, pg. 8, pg. 9).

In response to argument [c], Examiner respectfully disagrees.

Independent claim 1 recites:

"A computer-implemented apparatus for managing addresses of websites comprising:  
an address list...

    a monitor monitoring... and  
    an updating processor updating...

        wherein...

        wherein...so as to delete an address of a relocated or extinguished web site from said address list"

Initially, the following should be noted:

First, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. **It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.** See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed.Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its

teachings.”); In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

**See MPEP 2141 [IV]: Rationale Different from Applicant’s is permissible.**

In this case, it is not necessary that the prior art suggest the combination to achieve the same advantage or result of deleting an address of a relocated or extinguished web site.

In any case, Li throughout the disclosure suggests and/or teaches the deletion of the links of the moved web sites and/or deletion of addresses of inactive and/or dead web sites.

For example: At col. 5 L54 to col. 6 L3, col. 10 L7-20 and col. 11 L11-45, Li suggests deleting the moved documents during the refresh period.

In other words, Li explicitly discloses the process of managing the bookmarks, i.e. URLs, so as to delete the moved, i.e. delete an address of a relocated web site, during the refresh period by marking the link or url as deadlink and deleting the link or url according to user criteria, See fig. 19 and col. 12 L47 to col. 13 L10.

d. Chung teaches away from claim 1 (remarks, pg. 8).

In response to argument [d], Examiner respectfully disagrees.

In response filed, **applicant submits:**

Chung cannot teach or suggest at least the above-quoted features because the object of Chung is not directed to “delete an address of a relocated or extinguished Web site from said address list” rather the object of Chung is to resubmit the same request at a different time.

According to Chung, a response may not be received for a number of reasons, such as network congestion, server overload, server failure (see Chung, col. 7, lines 41-45). Therefore, according to Chung, these problems can be bypassed by resubmitting the same request at a different because many of these problems are transient in nature (see Chung, col. 7, lines 45-52).

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Accordingly, Chung is not concerned with "delet[ing] an address of a relocated or extinguished Web site from said address list" if the "number of times failure has occurred continuously becomes equal to a predetermined threshold value by failure of said tries", rather Chung is merely concerned dealing with transient problems, such as resubmitting the same request when a response is not received. As such, Chung does not teach or suggest the above- quoted features of claim 1 because, in light of the above, **Chung teaches away from claim 1.**

Chung discloses:

The same-site retry mode corresponding to button 68 performs a periodic retry of those service identifiers for which a response is not received within a predetermined time period. When a particular service request is submitted over a TCP/IP connection to the corresponding server, it may not receive a response for any of a number of different reasons, such as network congestion, server overload, server failure and the like. Because many of these problems are transient in nature, resubmitting the same request at a different time can often bypass the problem. Even if the

In other words, Chung is fully aware of the common problems such as congestion, server overload, server failure and **the like** associated with a URL and/or a web site.

Although, Chung does not explicitly disclose the moved and/or relocated website problem, the relocation of web sites is commonly known in the art. Web sites commonly move to different locations.

Chung also teaches that many of the problems such as congestion, server overload, server failure and **the like** are transient in nature, resubmitting the same request at a different time can **often** bypass the problem.

**Note that**, Chung **does not** disclose and/or teach that **all of these problems are transient** in nature and resubmitting the request **will** bypass the problem, or disclose that deleting an address of an unavailable web site can not be achieved, or that the retry mechanism can not be combined with prior art in any manner.



In other words, Chung does not criticize, discredit, or otherwise discourage the usage of retry mechanism and/or deleting an address of a relocated web site that would enable one of ordinary skilled in the art to allege Chung to teach away, See MPEP 2141.02 (VI) and In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004) [However, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....”].

For the at least these reasons, THE REJECTION IS MAINTAINED.

All prior responses by the Office in view of Li and Chung are incorporated herein and/or still apply.

#### **Specification**

The specification is objected under 37 CFR 1.75 (d)(1) as failing to provide the support for the recitation such as “updating processor”.

Since the specification fails to recite the term “updating processor”, **the term is interpreted as “updating section”**, which is disclosed throughout the specification, and the fact that the term “updating section” can be implemented as a computer program and/or program, **the term “updating processor” is interpreted as a computer program.**

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-4, 6 and 8-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Independent claim 1 recites:**

“A **computer-implemented apparatus** for managing addresses of websites comprising:  
an address list...  
a monitor monitoring... and  
an updating processor updating...”

Initially, it is unclear whether the claim, as a whole, is directed towards the physical apparatus and/or a computer program, due to the fact that the preamble is directed towards the apparatus and the body of the claim is implemented as a computer program, e.g. specification pgs. 7-9.

And, logically, as is known in the art, the computer program alone cannot be interpreted as an apparatus and/or vice versa.

Hence, the dual interpretation of the claims enables the scope of the claim unascertainable.

Claims 2-18 are rejected at least due to their dependency on claim 1.

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-4, 6, 8-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Independent claim 1 recites:**

**“A computer-implemented apparatus** for managing addresses of websites comprising:  
an address list...  
a monitor monitoring... and  
an updating processor updating...”

As set forth in 35 USC 112, second paragraph rejection, the claim might be directed towards the non-statutory subject matter such as a computer program and/or software.

Furthermore, the claim fails to fall into any of the enumerated categories of 35 USC 101 as set forth above for at least the following reasons:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

In other words, the claim lacks a positive recitation of a hardware element enabling the claim and/or the apparatus to be interpreted as a machine.

The claim, as recited, can be implemented as a program and/or software code (see applicant specification, pg. 28: browser assistant software, pg. 7-9: programs), a non-statutory

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subject matter for at least failing to fall into any of the four enumerated categories of the statutory subject matter as set forth above.

Claims 2-4, 6 and 8-18 are rejected for the same reasons as set forth in claim 1.

Note: A recording medium as in claim 20 is interpreted as hard disk, CD-ROM or a floppy disk (applicant's specification, pg. 28).

**Claim Rejections - 35 USC § 112**

The 35 U.S.C. 112, first paragraph rejection presented in the previous office action is withdrawn in light of remarks filed 3/24/08. More specifically, in light of cancelled claim 22.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6 and 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (hereinafter Li, US 6,631,496 B1) in view of Chung et al. (hereinafter Chung, US 6,012,090).

As per claim 1, Li explicitly discloses an apparatus for managing addresses of websites (fig. 19 and col. 1 L56 to col. 2 L57) comprising:

an address list containing addresses of website (col. 2 L36-46 to col. 3 L7, col. 11 L12-45);

a monitoring section monitoring a state of user references to web sites (col. 2 L36 to col. 3 L7, col. 10 L14-67); and

an updating section updating the contents of said address list according to the state of user references monitored by said monitoring section, said updating including deleting from and adding to the contents of said address list according to the state of user references wherein said deleting occurs based on access failure of a website, and wherein said updating section has a line connected for reference to the website (a connection capable of initiating the identifier), and if no input is supplied over a predetermined time period with respect to reference to any of the web sites, said updating section tries to

access each of the addresses contained in said address list and deletes an address from said address List so as to delete an address of a relocated, i.e. moved or extinguished web site from the list (col. 7 L15 to col. 8 L60, col. 10 L7 to col. 11 L45, and fig. 19; clearly summarizes Li's invention, col. 5 L54 to col. 6 L3, col. 12 L47 to col. 13 L10).

However, Li does not disclose a means wherein, if the number of times the access failure has occurred with respect to one of the addresses contained in said address list becomes equal to a predetermined threshold value, said updating section deletes the one of the addresses from said address list, said updating section tries to access each of the addresses contained in said address list and deletes an address from said address list if the number of times failure has occurred continuously becomes equal to a predetermined threshold value by failure of said tries (i.e. a typical "retry mechanism" before deleting the addresses from the list, or **testing** the number of times access failure has occurred before deleting the addresses from the list as per applicant).

Chung explicitly discloses a retry mechanism comprising determining, whether the number of times the access failure has occurred with respect to one of the addresses/identifiers contained in said address list or group becomes equal to a maximum number of retries, i.e. predetermined threshold value, by accessing the identifiers, i.e. addresses, a maximum number of times (col. 7 L38 to col. 8 L9; RETRY mechanism with a maximum number of retries in an event of a access failure, col. 5 L18-43).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Li in view of Chung, in order to delete the addresses from the list if the number of times failure has occurred becomes equal to a predetermined threshold value by failure of said tries (i.e. utilizing a retry mechanism before deleting the address).

One of ordinary skilled in the art would have been motivated because the retry mechanism is a widely available technique for **ensuring the availability** and/or status of the website (Chung, col. 7 L65 to col. 8 L10, col. 3 L23-30).

As per claim 2, Li discloses the apparatus further comprising a connection section accessing to an address contained in said address list in case the address is designated (i.e. in case the address is selected for access, col. 1 L56-67, col. 4 L21-34, col. 5 L34-53, col. 6 L4-21).

As per claim 3, Li discloses the apparatus wherein said monitoring section records the frequency of access to the address of each web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined threshold value (i.e. adding the address into the list of addresses based on its popularity or access times, col. 10 L14-30 and fig. 19).

As per claim 4, Li discloses the apparatus wherein said monitoring section records the frequency of access to the address of each web site as a content of said state of references, and said updating section deletes, from said address list, any of the addresses in said address list with an access frequency lower than a predetermined threshold value (fig. 19 and col. 11 L3-34).

As per claim 6, Li discloses an apparatus wherein the access frequency with respect to each of the web sites is updated each time access the web site results in success, and wherein when the access frequency is updated, said updating section makes a determination whether or not the access frequency has reached the predetermined threshold value (col. 10 L14 to col. 11 L45 and fig. 19).

As per claim 8, Li discloses the apparatus further comprising a supply section supplying a user with a setting window to enable the user to set the predetermined threshold value (col. 14 L30 to col. 15 L34 and fig. 19).

As per claim 12, Li discloses the apparatus wherein said updating section is activated when an operating system controlling said address management apparatus is activated (fig. 19, col. 3 L3-5).

As per claim 15, Li discloses an apparatus wherein the access frequency is the number of occurrences of access in a unit number of days, and said updating section is activated when the date is changed (col. 5 L54-67 and fig. 19).

As per claim 18, Li discloses the apparatus wherein said updating section is activated when the setting of the predetermined threshold value is changed by the user (fig. 19).

As per claims 9-11, 13, 14, 16, 17 and 19-21, they do not teach or further define over the limitations in claims 1-4, 6, 8, 12, 15 and 18. Therefore claims 9-11, 13, 14, 16, 17 and 19-21 are rejected for the same reasons set forth in claims 1-4, 6, 8, 12, 15 and 18.

#### **Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Peerey et al., US 5,960,429: Multiple Reference Hotlist for identifying frequently retrieved web page.
- b. Bates et al., US 6,100,890: Automatic Bookmarks.



**Conclusion**

Please Note: The teachings of the prior art shall not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.

**THIS ACTION IS MADE NON-FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is (571)272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal Divecha/

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